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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,799	11/20/2001	Sheng-Guo Wang		1612

7590 04/18/2005  
Dr. Sheng-Guo Wang  
2516 Radrick Ln  
Charlotte, NC 28262

EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ML

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/989,799	<b>Applicant(s)</b> WANG, SHENG-GUO	
	<b>Examiner</b> John Hoffmann	<b>Art Unit</b> 1731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

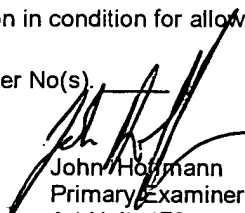
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 29.  
Claim(s) rejected: 21-28 and 30-34.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
John Hoffmann  
Primary Examiner  
Art Unit: 1731  
4-14-05

Continuation of 3. NOTE: The new issues are whether the changes to claims 21, 22, 24-26, 28 and 31-34 would make the claims allowable..

Continuation of 11. does NOT place the application in condition for allowance because: The arguments under applicant's section I. are not persuasive because the amendment is not entered.

As to section III (starting page 17 of response of 4-7-05, the arguments are not convincing as follows: (the lettering/numbers correspond to Applicant's)

A 1. 1. i The rejection indicates where it is disclosed; applicant has not pointed out any error.

ii. The rejection indicates where it is disclosed; applicant has not pointed out any error.

iii. This amendment was not entered

A1.2. a-f. It is unclear what the relevance of these things are. For example the claims do not require "continuous" measurement, a preform diameter monitor, etc.

A1.3. It is largely irrelevant that robustness is an advantage - because Yoshimura's process is robust (see rejection.). It may be that applicant's invention is more robust, but such is largely irrelevant because the claims do not require much robustness. For example even if Yoshimura has only 0.01% robustness and applicant's invention has 100% robustness, it is irrelevant because the claims do not require 100% robustness.

A2. Page 7 of the final Office Action clearly points out the motivation for combining Yamamura and Yoshimura. The allegation that the combination was done gratuitously and selectively, does not appear to be relevant; moreover there is no evidence or rationale to support the unfounded allegation. Page 9 of the final Office Action clearly points out the motivation for combining Urruti and Yamamura. As to "the significant factors" - this is not understood because it is substantially only claim limitations that matters - not other factors. As to the request for an explanation in accordance with MPEP 706.02: the rejection clearly points out the evidence, namely col. 1, lines 30-53 and col. 2 lines 64-67 of Yamamura.

A3.1. In response to applicant's argument that combining the processes would be inoperable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

A3.2. The fact that the references have different scope and content is not deemed very relevant. The all are evidence as to what one of ordinary skill in the art would know.

A3.3. Assuming i)-v) are true, such are not convincing because they are not relevant. Or at least they do not appear to be relevant to examiner because they are directed to features not claimed - and because applicant has not pointed out how they are relevant.

A3.4. This is incorrect. More importantly, there is no indication as to why this is relevant.

A3.5. In response to applicant's argument that combining the references would be inoperable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

A3.6. See A 1. 1. above.

A3.7. See the rejection for how this limitation is met. The claims do not preclude a predetermined diameter - in fact the claims require that the diameter is determined. Thus it must be predetermined -relative to the control. Applicant's invention does not have a post-determined diameter.

Examiner has reviewed the rest of Applicant's arguments. They are not convincing for substantially the same reasons given above. Namely, the arguments are directed to features that are not required by the claim; or they are based on allegation without any evidence or rationale to support them; or that they are deemed to be irrelevant because applicant has not pointed out why they are relevant and Examiner is not aware of any relevance.